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09/094,949 06/15/98 MERRIMAN

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EXAMINER

TM02/1114

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/094,949

Applicant(s)

MERRIMAN ET AL.

Examiner

Jennifer I. Harle

Art Unit

2761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

This Official Action contains numerous prior art rejections under both 35 U.S.C. §§ 102 and 103. These rejections were necessitated by the very broad claim language of Applicants. Each of the references utilizes different terms in describing Applicants' invention.

Applicants are reminded of their duty to disclose as required by 37 CFR 1.56.

### *Drawings*

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. Claims 1-2, 7-8, 50-51, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohda, et al. "Ubiquitous advertising on the WWW: Merging advertisement on the browser" (May 1996) (reference cited by Applicant).

As per claim 1, Kohda, et al. teaches a network comprising:

a user node having a browser program coupled to said network (Fig. 2),  
said user node providing request for information on said network (pg. 1495, col.  
1, fourth paragraph);

a content provider node having a content provider web site (Fig. 2 –  
Ordinary Web server and web page) responsive to requests for information from  
said user node to provide media content and advertising space for display of  
direct advertising content (Fig. 2);

an advertiser node having an advertiser web site including direct  
advertising content (Fig. 2 Advertiser's Web server and an advertisement web  
page), said advertiser node responsive to a request from said user node to  
provide said direct advertising content (pg. 1495, col. 1, Section 2.2), said  
advertiser node further providing a feedback signal representing user  
transactions at said advertiser node (pg. 1495, cols. 1-2, Sections 2.2 and 2.3  
and pg. 1498, Section 3.2); and

an advertisement server node responsive to a request from said user  
node and said feedback signal to select an advertiser node as a selected  
advertiser, and identify said advertiser node as said selected advertiser node to  
said user node (Fig. 2 Advertising agent web server; pg. 1495, cols. 1-2,  
Sections 2.2 and 2.3 and pg. 1497-98, Section 3.2),

whereby said direct advertising content from said selected advertiser node  
is displayed at said user node (pg. 1495, col. 1, Section 2.2).

As per claim 2, Kohda, et al. teaches selecting the advertiser node based on the characteristics of the user (pg. 1495, col. 1, Section 2.2 – "... tailor advertisements for individuals and their current interests ...").

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Kohda, et al. teaches a plurality of advertiser nodes (Fig. 2).

As per claim 8, Kohda, et al. teaches selecting the advertiser node based on the characteristics of the user (pg. 1495, col. 1, Section 2.2 – "... tailor advertisements for individuals and their current interests ...").

As per claim 50, Kohda, et al. teaches teaches a network comprising:

a user node having a browser program coupled to said network (Fig. 2), said user node providing requests for information on said network (pg. 1495, col. 1, fourth paragraph);

a content provider node having a respective content provider web site (Fig. 2 – Ordinary Web server and web page) responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Fig. 2);

a proxy node coupled to said user node and adapted for receiving a request from said proxy node (pg. 1498, Section 3.3);

an advertiser node having an advertiser web site including direct advertising content (Fig. 2 Advertiser's Web server and an advertisement web page), said advertiser node responsive to a request from said proxy node to provide said direct advertising content (pg. 1498, Section 3.3 in view of pg. 1495,

cols. 1-2, Sections 2.2 and 2.3), said proxy node further providing a feedback signal representing user transactions at said advertiser node (pg. 1495, cols. 1-2, Sections 2.2 and 2.3 and pg. 1498, Section 3.2); and

an advertisement server node responsive to a request from said user node and said feedback signal to select an advertiser node as a selected advertiser, and identify said advertiser node as said selected advertiser node to said user node (Fig. 2 Advertising agent web server; pg. 1495, cols. 1-2, Sections 2.2 and 2.3 and pg. 1497-98, Section 3.2),

whereby said direct advertising content from said selected advertiser node is displayed at said user node (pg. 1495, col. 1, Section 2.2).

Claims 61 and 62 are rejected for the same reasons as set forth in Claim 50. The method and apparatus steps are inherent to the function set forth for the proxy node taught by Kohda. Claim 61 includes a commerce engine in its recitation of a direct advertiser web site. Applicant defines a commerce engine as "any electronic or physical infrastructure that facilitates a transaction." (Pg. 11, lines 13-15) Kohda, et al. teaches that the advertising agent's web server can be linked to other pages which can include online order forms for the goods or services, i.e. an electronic infrastructure that facilitates the transaction. (Pg. 1495, Section 2.3)

As per claim 51, Kohda, et al. teaches selecting the advertiser node based on the characteristics of the user (pg. 1495, col. 1, Section 2.2 – "... tailor advertisements for individuals and their current interests ...").

As per claim 60, Kohda, et al. teaches a network comprising:

a first node having a browser program coupled to said network (Fig. 2 and pp. 1496-1497, Section 3.1), said first node responsive to a user at said first node to provide requests for information on said server (Fig. 2, pg. 1495, col. 1, fourth paragraph and pp. 1496-1497, Section 3.1);

a second node having a commerce engine web site, said second node having a transaction processor to implement a transaction responsive to a request from said user (pg. 1495, Section 2.3)

a third node between said first node and said second node, and coupled to said first and second nodes, said third node having a transaction monitor which monitors communication between said first node and said second node to determine whether a transaction requested by said user has occurred at said second node, and generate a feedback signal to report said transaction (pg. 1495, Section 2.3).

2. Claims 1, 7, 19, 25, 32, 38 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Wexler, U.S. Patent No. 5,960,409.

As per claim 1, Wexler teaches a network comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Col. 2, lines 43-46);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 3, lines 36-44; Col. 4, lines 28-36);

an advertiser node having an advertiser web site including direct advertising content, said advertiser node responsive to a request from said user node to provide said direct advertising content, said advertiser node further providing a feedback signal representing user transactions at said advertiser node (Col. 5, lines 1-23); and

an advertisement server node responsive to a request from said user node and said feedback signal to select an advertiser node as a selected advertiser, and identify said advertiser node as said selected advertiser node to said user node (Col. 4, lines 37-67),

whereby said direct advertising content from said selected advertiser node is displayed at said user node (Col. 4, lines 4-7).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Wexler teaches a plurality of advertiser nodes (Col. 5, lines 25-65).

As per claims 19 and 25, Wexler teaches an advertisement server node selecting an advertising banner and the advertiser node being responsive to a request from the user node to identify a direct advertiser web site corresponding to the advertising banner (Col. 4, lines 54-67; Col. 5, lines 1-13; Col. 5, lines 36-43). Wexler also teaches that the advertiser node has a direct advertiser web site including direct advertising content corresponding to said advertising banner, the advertiser node responsive to a request from the user node to provide the direct advertising content corresponding to the selection of the advertising



banner by the user, the advertiser node providing a feedback signal to the advertisement server node representing user transactions at the advertiser node (Cols. 4-5, lines 54-13).

As per claims 32, 38 and 44, see discussion above. It is noted that this claim appears to encompass what was well known in the art as click through.

3. Claims 1-2, 7-8, 19-20, 25-26, 32-33, 38-39, 44-45 and 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Angeles, et al., U.S. Patent No. 5,933,811.

As per claim 1, Angeles, et al. teaches a network comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Abstract; Col. 1, lines 44-55; Cols. 5-6, lines 62-3; Col. 8, lines 38-46; Col. 10, lines 43-54);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 3, lines 36-44; Col. 4, lines 28-36);

an advertiser node having an advertiser web site including direct advertising content, said advertiser node responsive to a request from said user node to provide said direct advertising content, said advertiser node further providing a feedback signal representing user transactions at said advertiser node (Col. 4, lines 6-16); and

an advertisement server node responsive to a request from said user node and said feedback signal to select an advertiser node as a selected

advertiser, and identify said advertiser node as said selected advertiser node to said user node (Cols. 7-8, lines 63-7; Col. 8, lines 55-65; Cols. 14-15, lines 59-31),

whereby said direct advertising content from said selected advertiser node is displayed at said user node (Cols. 2-3, lines 66-2; Col. 8, lines 62-65).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Angeles, et al. teaches that the "invention supports custom advertisements which can contain hyper-links to other information," i.e. these advertisements with their hyperlinks are equivalent to a plurality of advertiser nodes (Col. 4, lines 6-16).

As per claims 2 and 8, Angeles, et al. teaches an advertiser server node selecting the advertiser node based on the characteristics of the user (Col. 3, lines 58-62; Col. 8, lines 55-61; Col. 8, lines 55-62; Col. 14, lines 17-26).

As per claims 19 and 25, Angeles, et al. teaches an advertisement server node selecting an advertising banner and the advertiser node being responsive to a request from the user node to identify a direct advertiser web site corresponding to the advertising banner (Abstract, Col. 4, lines 6-16). Angeles, et al. also teaches that the advertiser node has a direct advertiser web site including direct advertising content corresponding to said advertising banner, the advertiser node responsive to a request from the user node to provide the direct advertising content corresponding to the selection of the advertising banner by the user, the advertiser node providing a feedback signal to the advertisement

server node representing user transactions at the advertiser node (Col. 4, lines 6-16; Col. 15, lines 1-31).

As per claims 32, 38 and 44, see discussion above. It is noted that this claim appears to encompass what was well known in the art as click through.

As per claims 20, 26, 33, 39 and 45, Angles, et al. teaches an advertiser server node selecting the advertiser node based on the characteristics of the user (Col. 3, lines 58-62; Col. 8, lines 55-61; Col. 8, lines 55-62; Col. 14, lines 17-26).

As per claim 60, Angeles, et al. teaches a network comprising:

a first node having a browser program coupled to said network, said first node responsive to a user at said first node to provide requests for information on said server (Abstract; Col. 1, lines 44-55; Cols. 5-6, lines 62-3; Col. 8, lines 38-46; Col. 10, lines 43-54);

a second node having a commerce engine web site, said second node having a transaction processor to implement a transaction responsive to a request from said user (Col. 4, lines 6-16); and

a third node between said first node and said second node, and coupled to said first and second nodes, said third node having a transaction monitor which monitors communication between said first node and said second node to determine whether a transaction requested by said user has occurred at said second node, and generate a feedback signal to report said transaction node (Cols. 7-8, lines 63-7; Col. 8, lines 55-65; Cols. 14-15, lines 59-31).

4. Claims 1-2, 7-8, 19-20, 25-26, 32-33, 38-39 and 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Minor, et al., U.S. Patent No. 5,740,252.

As per claim 1, Minor, et al. teaches a network comprising:

a user node having a browser program coupled to said network, said user node providing request for information on said network (Col. 1, lines 22-23; Col. 3, lines 37-43; Col. 6, lines 18-25);

a content provider node having a content provider web site responsive to requests for information from said user node to provide media content and advertising space for display of direct advertising content (Col. 1, lines 36-39; Col. 4, lines 19-28; Cols. 5-6, lines 61-5; Cols.6-7, lines 59-30);

an advertiser node having an advertiser web site including direct advertising content, said advertiser node responsive to a request from said user node to provide said direct advertising content, said advertiser node further providing a feedback signal representing user transactions at said advertiser node (Col. 6, lines 12-17; Col. 7-lines 59-66); and

an advertisement server node responsive to a request from said user node and said feedback signal to select an advertiser node as a selected advertiser, and identify said advertiser node as said selected advertiser node to said user node (Col. 4, lines 42-53; Col. 6, lines 13-17; Col. 7, lines 45-57),

whereby said direct advertising content from said selected advertiser node is displayed at said user node (Col. 6, lines 12-17).

As per claim 7, it is rejected under the same rationale as for claim 1 above. Claim 7 differs from Claim 1, if at all, in that it includes a "plurality of advertiser nodes." Minor, et al. teaches that the "reply may include a page with all the information necessary to compute a hyperlink transfer request at the user terminal," i.e. these replies with their hyperlinks are equivalent to a plurality of advertiser nodes (Col. 7, lines 59-64).

As per claims 2 and 8, Minor, et al. teaches an advertiser server node selecting the advertiser node based on the characteristics of the user (Col. 4, lines 42-53; Col. 6, lines 54-58; Col. 7, lines 49-57).

As per claims 19 and 25, Minor, et al. teaches an advertisement server node selecting an advertising banner and the advertiser node being responsive to a request from the user node to identify a direct advertiser web site corresponding to the advertising banner (Cols. 6-7, lines 59-57). Minor, et al. also teaches that the advertiser node has a direct advertiser web site including direct advertising content corresponding to said advertising banner, the advertiser node responsive to a request from the user node to provide the direct advertising content corresponding to the selection of the advertising banner by the user, the advertiser node providing a feedback signal to the advertisement server node representing user transactions at the advertiser node (Cols. 5-6, lines 61-5; Cols. 6-7, lines 59-57).

As per claim 32, 38 and 44, see discussion above. It is noted that this claim appears to encompass what was well known in the art as click through.

As per claims 20, 26, 33, 39 and 45, Minor, et al. teaches an advertiser server node selecting the advertiser node based on the characteristics of the user (Col. 4, lines 42-53; Col. 6, lines 54-58; Col. 7, lines 49-57).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-6, 9-12, 13-18, 19-24, 25-31, and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. "Ubiquitous advertising on the WWW: Merging advertisement on the browser" (Applicant's submission). Kohda, et al. teaches as discussed above in the 102(b) rejection.

As per claims 3, 9, 52, Kohda, et al. does not specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser.

As per claims 4, 10, 53, Kohda, et al. does not specifically disclose selecting the advertiser node based on the historical statistical conversion rate of

said direct advertising content. However, Kohda, et al. does disclose recording the actions of users in relation to a particular advertisement (i.e., reading its details or buying the goods or services) in order to prove the effectiveness of the advertising agent (pg. 1498, col. 2, Section 4). It would have been obvious for one of ordinary skill in the art at the time the invention was made to select the advertising node based on the actions of the users in relation to a particular advertiser and compile the data in order to prove effectiveness and then use this data (statistical compilation) to more effective fulfillment of the display rate contracted with the advertiser and make the advertising agent more competitive. This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area.

As per claims 5, 11, 54, Kohda, et al. does not specifically disclose selecting the advertiser node based on the cost per action of the direct advertising content. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select the advertising node based on the cost per action of the direct advertising content because the advertising agent it would enable fulfillment of the display rate contracted and it would enhance the competitiveness of the advertising agent.

As per claims 6 and 12, Kohda, et al. does not specifically disclose that the feedback signal is an email. However, email is a well-known method of feedback. See Ian S. Graham, HTML Sourcebook, 2<sup>nd</sup> Ed., (1996) Chapter 2, Page 46. It would have been obvious for one of ordinary skill in the art at the

time the invention was made to select email as the feedback signal due to the fact that email software is prevalent and thus, there would be no additional expense involved in facilitating the communication.

As per claims 19-20, 25-26, Kohda, et al. discloses as discussed above in the 102(b) rejection. Kohda, et al. does not disclose the specific display type/form/positioning of advertising, i.e. banner or interstitial, that would be selected. Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997, disclosed that banner ads are well known in the internet advertising field, that banner ads allow clicking through to the web site of the advertiser, and that in many instances substantially increased the advertiser's exposure. (Col. 3, lines 14-67); see *a/so* Peter N. Murray, U.S. Patent No. 6,061,659, filed June 3, 1997 (Cols. 1-2, lines 66-46) and Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997 (Col. 7, lines 59-65) (discussing banner advertisements and the problem with lack of targeting the consumer). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select and display an advertising banner in order to increase the efficacy of contact with users.

As per claim 55, Kohda, et al. discloses as discussed above in the 102(b) rejection of claim 50. Kohda, et al. does not disclose the specific display type/form/positioning of advertising, i.e. banner or interstitial, that would be selected. Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997, disclosed that banner ads are well known in the internet advertising field, that banner ads allow clicking through to the web site of the advertiser, and that in many



instances substantially increased the advertiser's exposure. (Col. 3, lines 14-67); see *also* Peter N. Murray, U.S. Patent No. 6,061,659, filed June 3, 1997 (Cols. 1-2, lines 66-46) and Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997 (Col. 7, lines 59-65) (discussing banner advertisements and the problem with lack of targeting the consumer). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select and display an advertising banner in order to increase the efficacy of contact with users.

Claim 56 is rejected for the same reason as set forth in the 103(a) rejection of claims 20 and 26 above.

As per claim 21, 27, and 57, Kohda, et al. does not specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. It would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser.

As per claim 22, 28, 58 Kohda, et al. does not specifically disclose selecting the advertiser node based on the historical statistical conversion rate of said direct advertising content. However, Kohda, et al. does disclose recording the actions of users in relation to a particular advertisement (i.e., reading its details or buying the goods or services) in order to prove the effectiveness of the advertising agent (pg. 1498, col. 2, Section 4). It would have been obvious for

one of ordinary skill in the art at the time the invention was made to select the advertising node based on the actions of the users in relation to a particular advertiser and compile the data in order to prove effectiveness and then use this data (statistical compilation) to more effective fulfillment of the display rate contracted with the advertiser and make the advertising agent more competitive. This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area.

As per claims 23, 29, and 59, Kohda, et al. does not specifically disclose selecting the advertiser node based on the cost per action of the direct advertising content. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select the advertising node based on the cost per action of the direct advertising content because the advertising agent it would enable fulfillment of the display rate contracted and it would enhance the competitiveness of the advertising agent.

As per claims 24 and 30-31, Kohda, et al. does not specifically disclose that the feedback signal is an email. However, email is a well-known method of feedback. See Ian S. Graham, HTML Sourcebook, 2<sup>nd</sup> Ed., (1996) Chapter 2, Page 46. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select email as the feedback signal due to the fact that email software is prevalent and thus, there would be no additional expense involved in facilitating the communication.

As per claim 13, Kohda et al. discloses an apparatus for delivery of direct advertisements from a plurality of advertisers in an advertising medium (Fig. 2) said apparatus comprising:

a memory storing database comprising a plurality of direct advertisements, (Fig. 2 – Advertising Agent's Web Server and pg. 1494, section 2.1 stating that “advertisements are stored on the agent's Web server) and historical results of previous placements of said plurality of direct advertisements in said advertising medium (pg. 1497-98, Section 3.2);

an advertisement server (Fig. 2 – can be either the Advertising Agent's Web Server or and Advertiser's Web Server) including a predictive model for selecting one of said plurality of advertisements based on said historical results;

an output device to display a selected done of said plurality of direct advertisements from a selected advertiser from said plurality of advertisers to a user (Fig. 2 – Augmented Web browser displayed on User's PC); and

a feedback signal to said advertisement server, said feedback signal providing the results of any transaction between said user and said selected advertiser, (pg. 1495, Section 2.3) said result being stored in said memory containing historical results of previous placements of said plurality of direct advertisements.

Kohda, et al. does not teach compiling the statistics for use in a predictive model for selecting one of said plurality of advertisements. It would have been obvious for one of ordinary skill in the art at the time the invention was made to compile the statistics in order to select the advertisement in order to more

effectively fulfill the display rate contracted with the advertiser and thus making the advertising agent more competitive. This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area.

The dependent claims 14-18 are rejected for the same reasons as discussed above in relation to claims 2-6 and 8-12, 20-24, 26-30, and 51-54.

6. Claims 3, 5-6, 9, 11-12, 21, 23-24, 27, 29-31, 34, 36-37, 40, 42-43, 46, and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler, U.S. Patent No. 5,690,409; Angeles, et al., U.S. Patent No. 5,933,811; or Minor, et al., U.S. Patent No. 5,740,252.

As per claims 3, 9, 21, 27, 34, 40 and 46, neither Wexler, nor Angeles, et al. nor Minor, et al. specifically disclose selecting the advertiser node based on the number of times the advertising content has been previously displayed. However, this pricing model for advertising is known in the art, i.e. CPM pricing. See Applicant's Specification, Background Section, Page 2. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to display the advertisement based on the number of times previously displayed because it would enable rotation of the advertisement and fulfillment of the display rate contracted with the advertiser.

As per claims 5, 11, 23, 29, 36, 42 and 48, neither Wexler, nor Angeles, et al. nor Minor, et al. specifically disclose selecting the advertiser node based on the cost per action of the direct advertising content. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select the

advertising node based on the cost per action of the direct advertising content because the advertising agent it would enable fulfillment of the display rate contracted and it would enhance the competitiveness of the advertising agent.

As per claims 6, 12, 24, 30-31, 37, 43 and 49, neither Wexler, nor Angeles, et al. nor Minor, et al. specifically disclose that the feedback signal is an email. However, email is a well-known method of feedback. See Ian S. Graham, HTML Sourcebook, 2<sup>nd</sup> Ed., (1996) Chapter 2, Page 46. It would have been obvious for one of ordinary skill in the art at the time the invention was made to select email as the feedback signal due to the fact that email software is prevalent and thus, there would be no additional expense involved in facilitating the communication.

7. Claims 4, 10, 13, 16, 22, 28, 35, 41 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angeles, et al., U.S. Patent No. 5,933,811.

As per claim 13, Angeles et al. discloses an apparatus for delivery of direct advertisements from a plurality of advertisers in an advertising medium (Fig. 4) said apparatus comprising:

a memory storing database comprising a plurality of direct advertisements, (Fig. 4, item 70) and historical results of previous placements of said plurality of direct advertisements in said advertising medium (Cols. 15-16, lines 56-7);

an advertisement server (Fig. 4 – Advertisement Provider Computer; Col. 13, lines 20-54) including a predictive model for selecting one of said plurality of advertisements based on said historical results;

an output device to display a selected one of said plurality of direct advertisements from a selected advertiser from said plurality of advertisers to a user (Fig. 4 – Consumer Computer; Col. 7, lines 52-60); and

a feedback signal to said advertisement server, said feedback signal providing the results of any transaction between said user and said selected advertiser, said result being stored in said memory containing historical results of previous placements of said plurality of direct advertisements (Cols. 3-4, lines 65-16; Cols. 15-16, 55-7).

Angeles does not et al. does not teach compiling the statistics for use in a predictive model for selecting one of said plurality of advertisements. However, Angeles, et al. does disclose monitoring the particular advertisements which are viewed by consumers (Cols. 3-4, lines 66-3). It would have been obvious for one of ordinary skill in the art at the time the invention was made to compile the statistics in order to select the advertisement in order to more effectively fulfill the display rate contracted with the advertiser and thus making the advertising agent more competitive. This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area.

As per claims 4, 10, 16, 22, 28, 35, 41 and 47 Angeles, et al. does not specifically disclose selecting the advertiser node based on the historical statistical conversion rate of said direct advertising content. However, Angeles, et al. does disclose monitoring the particular advertisements which are viewed by consumers (Cols. 3-4, lines 66-3). It would have been obvious for one of

ordinary skill in the art at the time the invention was made to select the advertising node based on the actions of the users in relation to a particular advertiser and compile the data in order to prove effectiveness and then use this data (statistical compilation) to more effective fulfillment of the display rate contracted with the advertiser and make the advertising agent more competitive. This type of statistical analysis of marketing programs is well known, i.e. sending out coupons and counting the number of redeemed coupons in a particular targeted area.

8. Claims 32–49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohda, et al. as applied to claims 1-5, 7-11, 19-29, 50-54 and 60 above, and further in view of Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997 or Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997 or Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997.

As per claims 32, 38 and 44, Kohda, et al. as discussed above does not teach the steps of sending a request from said user node to said advertisement server node responsive to selection of said advertising banner at said user node ... displaying said direct advertising content at said user node. However, these steps are merely a description of how a banner operates using click through technology. Davis, et al., U.S. Patent No. 5,796,952 filed March 21, 1997, disclosed that banner ads are well known in the internet advertising field, that banner ads allow clicking through to the web site of the advertiser, and that in many instances substantially increased the advertiser's exposure. (Col. 3, lines 14-67); see *also* Peter N. Murray, U.S. Patent No. 6,061,659, filed June 3, 1997

(Cols. 1-2, lines 66-46) and Douglas L. Peckover, U.S. Patent No. 6,119,101, filed January 17, 1997 (Col. 7, lines 59-65) (discussing banner advertisements and the problem with lack of targeting the consumer).

The dependent claims 33-37, 39-43 and 45-49 are rejected for the same reasons as discussed above in relation to claims 2-6 and 8-12, 20-24, 26-30, and 51-54.

### ***Double Patenting***

9. Applicant is advised that should claim 30 be found allowable claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

10. Claims 1-3, 7-9, 19, 25-27, 32-34, 38-40 and 44-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-10, 20, 32-39, 45-47 of U.S. Patent No. 5,948,061. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been an obvious variation to have a link from the advertiser node in lieu of the content provider affiliate node because it would enable the individual content provider to choose advertising which meets their criteria without reliance upon the advertiser.

11. Claims 1, 3-4, 7, 9-11, 19, 21-22, 25, 27-28, 32, 34-35, 50 provisionally rejected under the judicially created doctrine of double patenting over claims 1-3,



6, 19-20, 41-44 of copending Application No. 09/362,008. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: targeted advertising utilizing a user node, a content provider node, a proxy node (optionally), an advertiser node, and an advertisement server node. The main difference is that 09/362,008 claims collecting the prior activities of the user at the advertiser web site and broadly "retargeting" the advertising. However, the instant application clearly contemplates such action, albeitly more narrowly, where targeting is based on the historical statistical conversion rate of said direct advertising content and on the number of times the direct advertising content has been previously displayed at the user node. Thus, it appears that "retargeting" describes the specific actions set forth in the instant application.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such art is relevant to show the state of the art, where such is claimed by Applicant and to show various portions of Applicant's claims.

Leaf, U.S. Patent No. 5,754,772, May 19, 1998;

Rakavy, et al., U.S. Patent No. 5,913,040, June 15, 1999;

Levergood, et al., U.S. Patent No. 5,708,780, January 13, 1998; and

Draft HTML 2.0 Specification, September 22, 1995.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:00 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703.305.9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703.308.5357 for regular communications and 703.308.5357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.9700.

jih  
November 8, 2000

  
**TARIQ R. HAFIZ**  
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